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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/862,465

05/23/2001

Mark Landesmann

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08/14/2006

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/862,465

Applicant(s)

LANDESMANN, MARK

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-326 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date (2 sheets).
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 16,22-24,26,33,38-41,43-46,50-54,66,72-74,76,83,88-91,93-96,100-104,126-128,130,137,142-146,148-150,154-159,161,177,183-185,187,194,199-202,204-207,211-215,227,233-235,237,244,249-252,254-257,261-265 and 267-326.

Continuation of Disposition of Claims: Claims rejected are 1-15,17-21,25,27-32,34-37,42,47-49,55-65,67-71,75,77-82,84-87,92,97-99,105-125,129,131-136,138-141,147,151-153,160,162-176,178-182,186,188-193,195-198,203,208-210,216-226,228-232,236,238-243,245-248,253,258-260 and 266.

DETAILED ACTION

Restriction Election

1. Applicant's election without traverse of species 1 (claims 8, 9, 19-21, 34, 35, 47, 48, 58, 59, 69-71, 84, 85, 97, 98, 106-108, 123-125, 151, 152 and the corresponding system claims¹) in the reply filed on 17 April 2006 is acknowledged.
2. The following claims are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention: 16, 22-24, 26, 33, 38-41, 43-46, 50-54, 66, 72-74, 76, 83, 88-91, 93-96, 100-104, 126-128, 130, 137, 142-146, 148-150, 154-159, 161, 177, 183-185, 187, 194, 199-202, 204-207, 211-215, 227, 233-235, 237, 244, 249-252, 254-257, 261-265, 325 and 326.

Claim Rejections - 35 USC § 102 and 35 USC § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claims 1-15, 17, 18, 25, 27-29, 34, 35, 42, 47-49, 55-65, 67, 68, 75, 77-79, 84, 85, 92, 97-99, 105-122, 129, 131-133, 138, 139, 147, 151-153, 160, 162-176, 178-179, 186, 188-190, 195, 196, 203, 208-210, 216-226, 228, 229, 236, 238-240, 245, 246, 253, 258-260 and 266

¹ Each method claim 1-105 has a respectively corresponding system claim 162-266.

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are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (US 20040039639A1).

6. Walker et al. teaches (independent claims 1, 106 and 162) a method and system for determining a serious intent to purchase a good or service, the method comprising the steps of: receiving a declaration of intent to purchase a good or service (para. [0010]); obtaining a value of a serious intent rating (values in the *rating database 240*) for the buyer entity comprising a number used for estimating the likelihood that the buyer entity will make said purchase, and determining or having determined at least one benefit (*a reward offer*) that is associated with the intended purchase based on the serious intent rating for the buyer entity. (para. [0041]). For claim 106, Walker et al. also teaches receiving a proof that the purchase was made; and calculating or adjusting a value of a serious intent rating for said buyer entity based on receipt of said proof that the purchase was made (para. [0072]).
7. Walker et al. also teaches at the citations given above claims 2, 4, 6-11, 42, 47-49, 56-61, 92, 97-99, 105-108, 110, 112-116, 147, 151-153, 160, 163, 165, 167-172, 203, 208-210, 217, 219-222, 253, 258-260 and 266.
8. Walker et al. also teaches claims 14, 64, 119, 175 and 225 [0054-0056], and claims 55 and 216 [0062].
9. For claims 3, 5, 15, 27, 28, 29, 34, 35, 65, 77-79, 82, 84, 85, 109, 111, 120, 131-133, 136, 138, 139, 164, 166, 176, 188-190, 195, 196, 226, 238-240, 243, 245 and 246, Walker et al., also teaches a third party as the operator of *central server 101* [0027].
10. For claims 12, 13, 15, 17, 18, 25, 62, 63, 65, 67, 68, 75, 117, 118, 120-122, 129, 173, 174, 176, 178, 179, 186, 223, 226, 228, 229, 234, and 236, Walker et al. inherently teaches (para. [0054]-[0056]) a "threshold" rating as whatever rating level(s) is/are chosen to offer *reward(s)/benefit(s)*.
11. Claims 19-21, 30-32, 36, 37, 69-71, 80-82, 86, 87, 123-125, 134-136, 140, 141, 180-182, 191-193, 197, 198, 230-232, 241-243, 247 and 248 are rejected under 35 U.S.C. 103(a) as being obvious over Walker et al. (US 20040039639A1).
12. Walker et al. does not teach (claims 19-21, 69-71, 123-125, 180-182 and 230-232) basing the rating on the actual/declared number of purchases/amount spent. Because all are obvious and mathematically related measures of intent, it would have been obvious to one

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of ordinary skill in the art, at the time of the invention, to add to the teachings of Walker et al. that the rating be based on the actual/declared number of purchases/amount spent.

13. Walker et al. does not teach (claims 30-32, 36, 37, 80-82, 86, 87, 134-136, 140, 141, 191-193, 197, 198, 241-243, 247 and 248) local storage of intent ratings with cookies. Because cookies are well-known means for efficiently storing user-marketing data, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add local storage of intent ratings with cookies to the teachings of Walker et al.

Double Patenting

13. The **nonstatutory double patenting** rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1, 106 and 162 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14 and 71 of copending application No. 09862420. Although the conflicting claims are not identical, they are not patentably distinct from each other because, with one exception, the instant application claims are mere simplifications of the '420 application claims.
15. The instant claims are limited to the serious intent rating being an estimate of the likelihood

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of the purchase being made. While that limitation is not present in the '420 application claims, it is the most obvious definition of a serious intent rating.

16. Claims 1, 106 and 162 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17 and 78 of copending application No. 09862466. Although the conflicting claims are not identical, they are not patentably distinct from each other because, with one exception, the instant application claims are mere simplifications of the '466 application claims.

17. The instant claims are limited to the serious intent rating being an estimate of the likelihood of the purchase being made. While that limitation is not present in the '466 application claims, it is the most obvious definition of a serious intent rating.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 8:30 AM to 7 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

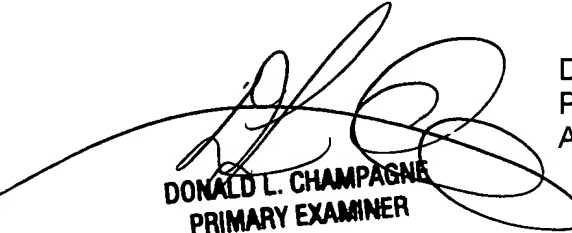
19. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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21. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

7 August 2006


DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622